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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,741	08/10/2001	Jonathan D. Reid	NOVLP020/NVLS-422	7293
22434	7590	10/07/2003	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778			NICOLAS, WESLEY A	
			ART UNIT	PAPER NUMBER

1742

DATE MAILED: 10/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/927,741

Applicant(s)

REID ET AL.

Examiner

Wesley A. Nicolas

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

This is in response to the Amendment submitted August 14, 2003. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-40 are currently pending in this application.

#### **Claim Rejections - 35 USC § 102**

1. Claims 1-2, 8-13, 16, 24-27, 29, 32-34, 37, and 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al. (U.S. 2002/0084183).

The rejection of claims 1-2, 8-13, 16, 24-27, 29, 32-34, 37, and 39-40 has been **maintained** and is as set forth in the previous Office action which is incorporated herein. Examiner's arguments for maintaining the rejection are set forth below in the "Response to Argument/Amendment."

In response to Applicant's amendment to claim 1, line 11 adding the limitation, "*and proximate the cup's lip*", Examiner maintains that the previously applied rejection of claim 1 can also apply to newly amended claim 1 without modification, for the reasons as set forth below in the "Response to Argument/Amendment."

In response to Applicant's amendment to claim 24, lines 10-11 adding the limitation, "defined by the cup and the field shaping element", Examiner maintains that the previously applied rejection of claim 24 can also apply to newly amended claim 24 without modification, for the reasons as set forth below in the "Response to Argument/Amendment."

**Claim Rejections - 35 USC § 103**

2. Claims 3-4, 18-21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (U.S. 2002/0084183) as applied to claims 1, 2, and 29 above, and further in view of Keigler (6,540,899).

The rejection of claims 3-4, 18-21 and 30 have been **maintained** and are as set forth in the previous Office action which is incorporated herein. Examiner's arguments for maintaining the rejection are set forth below in the "Response to Argument/Amendment."

3. Claims 14-15, 17, 22-23, 35-36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (U.S. 2002/0084183) as applied to claims 1 and 24 above, and further in view of Schuster et al. (5,000,827).

The rejection of claims 14-15, 17, 22-23, 35-36, and 38 have been **maintained** and are as set forth in the previous Office action which is incorporated herein. Examiner's arguments for maintaining the rejection are set forth below in the "Response to Argument/Amendment."

4. Claims 5-7 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (U.S. 2002/0084183) as applied to claims 1 and 24 above, and further in view of Uzoh et al. (6,413,388).

The rejection of claims 5-7 and 31 have been **maintained** and are as set forth in the previous Office action which is incorporated herein. Examiner's arguments for

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maintaining the rejection are set forth below in the "Response to Argument/Amendment."

### **Allowable Subject Matter**

5. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The specific immersion of the work piece that takes place at an angle in which the plating surface is not parallel to the plane defined by the plating fluid surface was not taught or suggested by the prior art of record.

### **Response to Argument/Amendment**

7. Turning to Applicant's arguments regarding the amendment to claim 1, Applicant asserts that adding the limitation, "*and proximate the cup's lip*", distinguishes over the prior art of record. Examiner must respectfully disagree for the following reasons:

First, Examiner maintains that the "inlet" of Hanson et al. is actually "proximate" to the cups lip (see flow region which is above numeral 200 in Fig. 7). Furthermore, "proximate" as claimed by the Applicant has been given its broadest possible meaning in light of the supporting disclosure. In re Zletz, 893 F.2d 319, 321-22, 13

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USPQ2d 1320, 1322 (Fed. Cir. 1989). As such, "proximate" is being given its ordinary dictionary definition which is "very near" (Merriam Webster's Collegiate Dictionary, 10<sup>th</sup> Ed.) and Examiner considers the flow region above numeral 200 (Fig. 7) to be "very near" to the cup's lip.

Second, the flow path claimed and argued by Applicant is substantially similar if not identical to that disclosed by Hanson et al. For example, Applicant argues in Paper # 5, page 7 that, *"Fig. 1E....Flow path 147 is defined by field shaping element 127 and cup 125. The inlet of this defined region is proximate lip 131 of cup 125."* The table below will show why Applicant's invention is similar if not identical to that of Hanson et al.

Instant Invention		Hanson et al. (2002/0084183)
Fig. 1E, flow path 147	→	Region between Fig. 7, num. 200 and bottom of 60
Fig. 1E, field shaping element 127	→	Fig. 7, numeral 200
Fig. 1E, cup 125	→	Fig. 7, numeral 60 and adjacent elements
Fig. 1E, inlet 131	→	Fig. 7, area between numeral 60 and numeral 200

In light of the table above, the "flow path" limitation in claim 1 of Applicant's invention, Fig. 1E (which Applicant argues depicts the flow path limitation), and Fig. 7 of Hanson et al., one can deduce that while the structural elements set forth in Fig. 7 of Hanson et al. are not of the exact shape of those depicted in Fig. 1E of the supporting disclosure (curved field shaping element vs. Hanson et al.'s flat field shaping element), Hanson et al. still anticipates Applicant's claimed invention.

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Third, even though Applicant argues (see page 8 of Paper # 5) that the field shaping elements of Hanson et al. (Fig. 7, numerals 195 and/or 200) are disposed *parallel* to the workpiece 45 (Fig. 7), it makes no difference as to their orientation to one another because they still anticipate Applicant's claimed invention because Hanson et al. teach an inlet on the inside of the apparatus proximate the cup's lip (see Fig. 7, region between numerals 60 and 200). The features upon which applicant relies (i.e., field shaping element not parallel to workpiece) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Now turning to Applicant's arguments regarding the amendment to claim 24, Applicant asserts that adding the limitation, "*defined by the cup and the field shaping element*", distinguishes over the prior art of record for the same reasons as claims 1-23 distinguish over the prior art of record. Examiner must respectfully disagree for the following reasons:

First, Hanson et al. does show a flow path defined by the cup (Fig. 7, numeral 60) and a field shaping element (Fig. 7, numeral 200). Although Hanson et al. does not indicate specific arrows showing a flow path, fluid still flows in between the cup (Fig. 7, numeral 60) and the field shaping element (Fig. 7, numeral 200), such flow is discussed in ¶ 0054.

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Second, since Applicant gives no other reason that claim 24 is patentable other than the reasons with respect to claims 1-23, Examiner also applies the same arguments as set forth above with respect to claim 1.

With respect to the dependent claims, since Applicant has not argued the merits of Examiner's rejection of said dependent claims, their rejection has been maintained. As such, dependent claims whose merits are not separately argued from their independent claims stand or fall with it. In re Kulling, 14 USPQ2d 1056 (Fed. Cir. 1990).



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***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

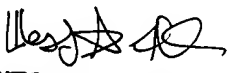
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley Nicolas whose telephone number is (703)305-0082. The examiner can normally be reached on Mon.-Thurs. from 7am to 5pm.

The Supervisory Primary Examiner for this Art Unit is Roy King whose telephone number is (703) 308-1146.

The fax number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
**WESLEY A. NICOLAS**  
**PATENT EXAMINER**

October 2, 2003